

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Giacomo Digrigoli et al.	Examiner:	Frantzy Poinvil
Serial No.:	10/608,525	Group Art Unit:	3692
Filed:	June 26, 2003	Docket No.:	2043.114US1
Title:	MULTICURRENCY EXCHANGES BETWEEN PARTICIPANTS OF A NETWORK-BASED TRANSACTION FACILITY		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicants request review of the final rejection in the above-identified application in Final Office Action mailed May 1, 2008. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated below:

§102 Rejection of the Claims

Claims 1-37 were rejected under 35 U.S.C. § 102(e) for anticipation by Boesch et al. (U.S. Patent No. 5,897,621, hereinafter, "Boesch").

Applicants respectfully submit that the rejection of claims 1-37 under 35 U.S.C. § 102(e) is defective for the reason that Boesch does not disclose each and every limitation of the independent claims of the present application.

To anticipate a claim, the reference must teach every element of the claim.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Applicants believe that the issue of patentability of the independent claims 1, 24, 31, 34, 35, 36 and 37 over Boesch is best understood with regard to claim 1.

Claim 1 includes the following limitations:

informing a recipient via the communications network about the payment in the sender-selected currency.

The Final Office Action relies upon the following quotes from Boesch, which fail to disclose informing a recipient via the communications network about the payment in the sender-selected currency.

The present invention is directed to approval of multi-currency transactions in which the customer user 203 pays in a first currency and the merchant user 303 accepts the payment in a second currency which differs from the first currency.¹

....Thus, the merchant user 303 will accept a price and receive payment for the product sold to the customer user 203. The price for the product is in a currency accepted by the merchant user 303, referenced herein as the "price in the merchant accepted currency P(MAC)". The customer user 203 will pay an amount to the merchant user 303 for a selected product. The amount will be paid in a currency selected by customer user 203, referenced herein as the "amount in the customer selected currency A(CSC)". The currency selected by the merchant user 303 is different than the currency selected by the customer user 203. Hence, currency exchange is used to approve the transaction contemplated by the present invention.²

The above two quotes from Boesch relate to a "multi-currency transaction."³ The "multi-currency transaction" includes different first and second currencies. Boesch identifies the "first currency" as a "customer selected currency A(CSC)" and the "second currency" as a "merchant accepted currency P(MAC)." The first currency is selected by the customer who pays an amount for a product in the customer selected currency. The second currency is accepted by the merchant who receives a price for the product in the merchant accepted currency. In another quote Boesch explains, "the customer user 203 and the merchant user 303 do not bear the above-described risks associated with currency exchange."⁴ Rather, "It is the entity charged with performing actual settlement of the transaction who bears such risks when the transaction is actually settled."⁵

Claim 1 requires informing a recipient via the communications network about the payment in the sender-selected currency. In contrast, the above quote from Boesch relates a multi-currency transaction that includes a customer who pays in first currency and a merchant

¹ Boesch, col. 6, lines 63-68.

² *Id.*, col. 7, lines 7-18.

³ *Id.*, col. 6, lines 11-19.

⁴ *Id.*, col. 6, lines 53-57.

⁵ *Id.*, col. 6, lines 60-63.

who accepts payment in a second currency. Specifically, Boesch relates a merchant who accepts payment in a “merchant accepted currency P(MAC).” For example, if the “recipient” in claim 1 corresponds to the “merchant” in Boesch and the “sender” in claim 1 corresponds to the “customer” in Boesch, then nowhere does the above quote from Boesch disclose the “informing [the] recipient.... about the payment in the sender-selected currency,” as required by the limitations of claim 1. Moreover, it is unclear why a “merchant” who receives “payment” in a currency that is accepted by the merchant would have any interest in a currency that is selected by the “customer.” Indeed, Boesch relates a system that is fundamentally different from the subject matter of claim 1. Boesch therefore cannot be said to anticipate the above quoted limitation because Boesch relates a customer who pays an amount in a currency selected by the customer, an entity who bears the risk of a currency exchange, and a merchant who accepts payment in a “merchant accepted currency P(MAC).” In contrast, claim 1 requires informing a recipient via the communications network about the payment in the sender-selected currency. These are distinguishable actions.

In summary, because Boesch does not disclose each and every limitation of claim 1, it fails to make a *prima face* showing of anticipation as is required to support a rejection of this claim under 35 U.S.C. § 102(e).

The above remarks are also applicable to a consideration of independent claims 24, 31, 34, 35, 36 and 37.

As dependent claims are deemed to include all limitation of claims from which they depend, the rejection of claims 2-23, 25-30, 32 and 33 under 35 U.S.C. § 102(e) is also addressed by the above remarks, and the amendments contained herein.

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Page 5
Dkt: 2043.114US1

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 408-278-4046 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 31 day of July 2008.

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